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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,516	11/21/2003	Yiwen Tang	50623.304	3018
Victor Repkin Squire, Sanders & Dempsey L.L.P. 1 Maritime Plaza, Suite 300 San Francisco, CA 94111			EXAMINER ROGERS, JAMES WILLIAM	
			ART UNIT	PAPER NUMBER
			1618	
			MAIL DATE	DELIVERY MODE
			03/17/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/719,516

Applicant(s)

TANG ET AL.

Examiner

JAMES W. ROGERS

Art Unit

1618

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
 b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: _____.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
 12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
 13. ☐ Other: _____.

/Michael G. Hartley/
 Supervisory Patent Examiner, Art Unit 1618

Continuation of 11, does NOT place the application in condition for allowance because: As detailed in previous office actions it is the position of the examiner that since the polymers taught in the references above are the same as applicants claimed polymers (PCL, PLA and PGA) they will inherently have the same properties including Tg and degree of crystallization. Applicants have not set forth in their claims or within the specification how their polymers would have a different degree of crystallization and Tg than those same polymers known in the art or that are commercially available. The references presented by applicants do indeed show that polymers with different molecular weights (size) and particle sizes do exhibit different degrees of crystallization, however applicants have not recited within their claims any physical feature of the polymers (MW or particle size) that would exclude the polymers within the references above. The examiner can only search for what is claimed, since the polymers claimed are within the same in scope as what is described in the references above the examiner assumes that any property derived from those polymers is also necessarily the same. All of the applied references above teach the same coatings comprised of the same polymeric blends as claimed by applicants e.g. PCL and PHB. The polymers disclosed in those references also either recite or inherently teach the same Tg as claimed by applicants. It is well known in the art that the glass transition temperature Tg and the melting temperature Tm of a polymer is inherently linked to its crystalline structure. See Odian Principles of polymerization pp 24-33, cited previously. Thus it is the position of the examiner that since the polymers claimed are the same and their Tg values are the same the polymers will inherently have the same degree of crystallization as applicants claimed polymer blend because crystallinity and glass transition temperatures are inherently linked. Also applicants own specification at [0035] of the US PGPUB 20050112171 A1 states "the crystallinity of 3-PHB is about 80% while that of PCL is about 57%" thus as evidenced from applicants own specification it would appear that inherently 3-PHB (described as an additive) has a higher degree of crystallinity than PCL (described as a 1st polymer), thus since all of the above references teach blends of PCL and PHB the limitation is inherently met. It appears as though applicants are trying to claim an undisclosed or unknown property of an old polymeric blend. Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case or either anticipation or obviousness has been established. Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable.